

AMENDMENTS TO THE DRAWINGS

Please replace drawing sheets no. 1-4 including Figs. 1A-1J with the substitute sheets attached.

REMARKS

The Specification has been amended to correct minor informalities. Specifically, Paragraph [0012] has been amended to explain the change of designation of dirty blocks with an asterisk "*" for clarity, and Paragraph [0014.1] is based upon the deleted portions from Paragraph [0014]. All changes are supported by the original written description. No new matter has been added.

The **Abstract** of the invention stands objected to for the improper content of the first sentence. Applicants respectfully adopt the suggestion of the Examiner and amend the Abstract accordingly to comply with the requirements of MPEP § 608.01(b).

FIGs. 1A - 1J have been amended to comply with the requirements of 37 C.F.R. 1.84 and 37 C.F.R. 1.121(d). Specifically, **FIG. 1A** and **FIGs. 1C – 1I** are amended to add the missing reference characters. **FIG. 1J** is amended to add the missing reference characters and to correct other minor informalities.

Claims 1, 3, 21-23, 25, and 31 are currently amended to clarify the present invention, without acquiescence in cited basis for rejection or prejudice to pursue in a related application.

CLAIM OBJECTIONS

Claim 3 is objected to for containing a typographical error. Claim 3 is currently amended to replace the word "firs" with "first." Applicants respectfully submit that said amended claim 3 overcomes the objection.

§ 101 REJECTION

Claim 31 stands rejected under 35 U.S.C. § 101 because the claimed invention of claim 31 is directed to non-statutory subject matter for not being limited to tangible embodiments.

Claim 31 is currently amended to replace the phrase "computer usable medium" with "computer usable storage medium." Applicants respectfully submit that the amended claim 31 is

therefore limited to tangible embodiments and thus overcome the rejection under 35 U.S.C. § 101.

§ 102 REJECTIONS

Claims 1 - 7, 12 - 13, 15, 19, 21 - 24, 28 - 29, and 31 under 35 U.S.C. § 102(e) stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent Number 6,907,499 issued on June 14, 2005 to Herbst et al. (hereinafter Herbst.) Applicants respectfully traverse. Applicants note that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131. Applicants further respectfully note that the cited reference in the Office Action qualifies as prior art under 35 U.S.C. § 102(e) and reserve the right to swear behind one or more of the references as prior art.

Claim 1, as currently amended, recites at least the following claimed limitations “tracking a total number of the identified first and additional data blocks”. Claims 21 and 31 recite similar limitations. Applicants respectfully submit that the cited passages, **col. 2, ll. 4-49**, of Herbst do not disclose, teach, or suggest the above claimed limitations of claim 1. The cited passages first disclose a method of managing read commands and disc write operations by discontinuing the write operation when the disc drive receives a read command. Herbst, **col. 2, ll. 4-14**. The cited messages then disclose a method of freeing up the host by informing the host that data is written immediately upon storing the data in the write cache. *Id.* **col. 2, ll. 15-24**. The cited passages further disclose a method of locating and coalescing data blocks that are to be written to the disc in contiguous data blocks in a single write command. *Id.* **col. 2, ll. 25-40**. Finally, the cited passages disclose a method of possibly reducing time to access the disc by first checking the write cache to determine whether the requested data is in the write cache before attempting to read the requested data from the disc. *Id.* **col. 2, ll. 41-49**. As such, the cited passages are absolutely silent on tracking the number of identified data blocks.

For at least the foregoing reasons, claims 1, 21, 31, and their respective dependent claims are allowable over Herbst.

§ 103 REJECTIONS

Claims 8 - 11, 14, 16 - 18, 20, 25 - 27, and 30 stand rejected as being unpatentable over Herbst under 35 U.S.C. § 103(a).

The Office Action acknowledges that Herbst does not specifically disclose the claimed limitations of searching the storage alternatively, yet states that Herbst nonetheless renders the claimed limitations obvious since it is obvious for one skilled in the art to search both the lower and upper addresses, and that Official Notice is thus taken. Applicants respectfully traverse. Applicants respectfully note that the Office Action does not point to any evidentiary support for the Official Notice. While the Office Action acknowledges that Herbst does not specifically disclose that sequentially searching the first storage location is conducted alternatively, it nevertheless states that since it is obvious to search for both the upper and lower address, the claimed limitations of sequentially searching the first storage location alternatively is rendered obvious. That is, the logic in the Office Action is that Herbst does not disclose A (sequentially search the first storage location alternatively), but since it is obvious to do B (search for both the upper and lower addresses), A is thus obvious. In fact, Applicants note that Herbst is absolutely silent on searching for the data blocks in any particular sequence. Applicants therefore respectfully submit that the Office Action fails to explain the bases for the obvious rejection and thus, Herbst cannot support the obviousness rejection pursuant to MPEP 2144.02.

Furthermore, Applicants respectfully submit that “[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based” and “The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” MPEP 2144.03. As such, should the Examiner maintain the rejection of these claims in question, Applicants respectfully ask the Examiner to produce authority for the basis of the statement that Herbst’s lack of disclosure of sequentially searching for the data blocks would nonetheless render obvious the specifically disclosed search sequences of the claims in question.

CONCLUSION

On the basis of the above remarks, all claims are believed to be allowable. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Bingham McCutchen's Deposit Account No. **50-2518**, referencing billing number **7030762001**. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Bingham McCutchen's Deposit Account No. **50-2518**, referencing billing number **7030762001**.

Respectfully submitted,
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